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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/010,187 | 12/06/2001 | Barbara Haviland Minor | FL-1068 US NA | 2859 |

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E I DU PONT DE NEMOURS AND COMPANY
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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

HARDEE, JOHN R

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1751

DATE MAILED: 08/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,187

Applicant(s)

MINOR ET AL.

Examiner

John R Hardee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 8, 9. 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to compositions comprising polyoxyalkylene glycol ethers, classified in class 252, subclass 68 et al.
 - II. Claims 1-11, drawn to compositions comprising amides, classified in class 252, subclass 68 et al.
 - III. Claims 1-11, drawn to compositions comprising ketones, classified in class 252, subclass 68 et al.
 - IV. Claims 1-11, drawn to compositions comprising nitriles, classified in class 252, subclass 68 et al.
 - V. Claims 1-11, drawn to compositions comprising chlorocarbons, classified in class 252, subclass 68 et al.
 - VI. Claims 1-11, drawn to compositions comprising aryl ethers, classified in class 252, subclass 68 et al.
 - VII. Claims 1-11, drawn to compositions comprising 1,1,1-trifluoroalkanes, classified in class 252, subclass 68 et al.
 - VIII. Claims 1-11, drawn to compositions comprising fluoroethers, classified in class 252, subclass 68 et al.

The inventions are distinct, each from the other because of the following reasons:

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The inventions are patentably distinct. A disclosure of one of the inventions would not anticipate or make obvious any of the other inventions.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Mark Edwards on July 28, 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. No claims were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, but the claims were searched and examined only to the extent that they read on the elected invention.

4. Applicant has requested that the election be broadened to include the polyoxyalkylene glycol ethers. The examiner declines to do so, because the elected subject matter already covers a generous variety of different inventions, such as lubricants, refrigerants, solubilization methods and lubrication methods, between which the examiner has not restricted.

5. Claim 8 is withdrawn from consideration by the examiner as being drawn to an invention non-elected without traverse.

6. The restriction requirement is made FINAL.

Claim Objections

7. Claims 7, 8 and 11 are objected to because of the following informalities: These claims modify independent inventions in different statutory classes. For the sake of clarity, the examiner recommends that this be done with separate dependent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 612,839 A1. The reference discloses liquid compositions for refrigeration systems comprising at least one fluoride-containing hydrocarbon; an additive which may be a fatty amide; and a lubricant (abstract). Suitable amides are depicted schematically at p. 6, line 15. Viscosity improvers may be added to the compositions (p. 18, lines 36+). These include polyolefins such as polybutene and polyalkyl styrenes. Viscosity adjusters such as polyalkyl styrenes, naphthenic oils, alkyl benzene oils may be added. A ratio of such additives to fatty amide is not disclosed, but the examiner notes that the prior-art lubricant is present in much larger amounts than the amide, so a substantial amount of additive, relative to amide, would be necessary to adjust the viscosity of the lubricant. Accordingly, it appears that the claimed ratio of hydrocarbon to amide can be met in the course of optimizing the viscosity of the lubricant.

Allowable Subject Matter

12. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record is the reference relied upon above. The reference

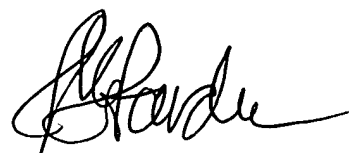
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does not disclose or make obvious the use of cyclic tertiary amides as claimed by applicant.

14. Any prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. Hardee', with a stylized, cursive script.

John R. Hardee
Primary Examiner
July 30, 2003